

**REMARKS**

The present invention relates to a method for filling the gap between two lengths of coated pipe in which a polyurethane-forming composition is employed.

Applicant notes with appreciation that the rejection of Claims 1-11 under 35 U.S.C. §112, second paragraph, has been withdrawn in view of the amendments to the claims made in Applicant's previous response.

Claims 1-11, 13-29 and 31-32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hagquist (U.S. 6,288,133) in view of McBrien et al (U.S. 5,328,648) and Isobe et al (U.S. 6,433,033). Applicant continues to respectfully traverse this rejection.

The Hagquist, McBrien et al and Isobe et al references were discussed and distinguished over the claimed invention in Applicant's previous response. This discussion will not be repeated. Rather, Applicant will address the specific points raised in the Office Action of March 8, 2006.

Applicant is claiming a method for filling a gap at the junction between two lengths of coated pipe.

Only one of the cited references, i.e., McBrien et al is directed to a method for filling in this same type of gap. McBrien et al teaches:

The joint infill material of this invention is preferably made of a fast setting elastomeric polymer which will set up in a few minutes so that the pipe can be handled without fear of damage to the joint infill. Preferred polymers include the rapid setting solid polyurethanes... (at column 5, lines 3-7 of U.S. 5,328,648)

Neither Hagquist nor Isobe et al discloses such a method. Further, neither Hagquist nor Isobe et al teaches or suggests that the compositions disclosed therein would be suitable for such applications.

Why then would one skilled in the art seeking to fill a gap between two lengths of coated pipe "select" a composition based upon the combined teachings of Hagquist and Isobe et al from the thousands of possible fast setting polymers known and available in the art?

Applicant maintains that there is no teaching in either Hagquist or Isobe et al which would lead one skilled in the art to select any composition based upon its/their teachings from the thousands of other possible compositions.

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It is well established that obviousness can not be established by locating references which describe various aspects of an innovation **unless** the Patent Office also provides evidence of a motivating force which would lead one skilled in the art to do what Applicant has done. Ex parte Levensgood, 28 USPQ2d 1300 (Bd. App. 1993)

In the present case, the Hagquist and Isobe et al references do not provide such evidence. The Hagquist compositions are taught to be useful for filling spike holes in railroad ties, reinforcing composite structural building materials, well repair and concrete repair. Isobe et al's compositions are taught to be useful for interior trims of vehicles, cushioning materials for furniture, bedding and miscellaneous goods. None of the applications for the compositions disclosed in the Hagquist or Isobe et al references requires the rapid set and strength requirements for a joint infill composition. One skilled in the art trying to select a suitable fast setting polyurethane for use in filling the gap between two coated pipes would not therefore be led by the teachings of Hagquist and Isobe et al to select any of the compositions disclosed therein or a modified version of any of the compositions disclosed therein.

Further, no other evidence of a motivating force for selecting a polyurethane composition satisfying the compositional requirements of Applicant's claims from the thousands of possible quick setting polyurethanes has been provided by the Patent Office.

The teachings of McBrien et al can not therefore be properly combined with the teachings of Hagquist and Isobe et al in the manner suggested by the Examiner.

It is stated in the Office Action that Hagquist's teachings with respect to flow enhancement of reactants supports the rejection of Applicant's claims.

Applicant would point out, however, that no relationship between flow enhancement, cure rate, material strength and low potential for environmental contamination is taught or suggested by Hagquist or by any other authority. It can not properly be assumed that a material which promotes flow enhancement will also be suitable for inclusion in compositions for filling a gap at the junction between two lengths of coated pipe.

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The mere fact that Hagquist teaches use of a material such as TXIB as a flow enhancer can not therefore be properly construed as a teaching that TXIB will be suitable for use in an joint fill composition in accordance with Applicant's claimed method.

The In re Aller, 105 USPQ 233 (CCPA 1955), In re Reese, 129 USPQ 402 (CCPA 1961) and In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) cases which were cited as support for the rejection of Applicant's claims are distinguishable from the present case on their facts.

More specifically, in each of the above-listed cases, the claimed invention was the result of optimization of the prior art - not selection of a material from unrelated prior art.

In In re Aller, *supra*, the invention claimed was identical with that of the prior art with the exception that lower temperatures and higher acid concentrations were being claimed. The materials used in the cited prior art process and the process being claimed were the same. In contrast, McBrien et al (the only cited reference directed to a process of the type being claimed by Applicant) does not disclose the same materials required in Applicant's joint fill composition.

In In re Reese, *supra*, the invention being claimed was a composition in which the components were the same as those present in the cited prior art composition. The only difference between the two compositions was the proportion in which those same components were employed. In contrast, in the present case, the only reference directed to the same type of process as that which is being claimed by Applicant, i.e., McBrien et al, does not disclose any composition employing the same materials required in the composition used in Applicant's joint filling process.

In In re Boesch, *supra*, the alloys being claimed included the same elements as the alloys taught by the cited prior art. The only difference between the prior art alloys and those being claimed was the relative amount of the elements. However, in the present case, McBrien et al (the only reference directed to the same type of process as that which is being claimed by Applicant) does not disclose any composition employing the same materials required for the composition in Applicant's joint filling process.

The cited cases do not therefore support the rejection of Applicant's claims.

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In short, it can not properly be assumed that teachings with respect to materials which enhance flow of compositions used to fill holes and materials which produce durable molded foams would make the "suitability" of these materials for use in a joint filling composition obvious to one of ordinary skill in the art.

Combination of the teachings of Hagquist and Isobe et al with the teachings of McBrien in the manner suggested in the Office Action would not therefore be obvious to one of ordinary skill in the art who has not had the benefit of reading Applicant's specification. The combined teachings of McBrien et al, Hagquist and Isobe et al do not therefore provide the basis for a proper rejection of Applicant's claims under 35 U.S.C. §103.

Withdrawal of this rejection is therefore requested.

Claims 1-11, 13-29 and 31-32 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-13 of U.S. Patent No. 6,521,673 in view of McBrien et al (U.S. Patent 5,328,648).

The present application and U.S. Patent No. 6,521,673 are commonly owned. A terminal disclaimer over U.S. Patent 6,521,673 is enclosed.

It is believed that the filing of this terminal disclaimer removes U.S. Patent 6,521,673 as the basis for this rejection and thereby overcomes this rejection.

Claims 1-11, 13-29, 31 and 32 have also been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-6, 8-45, 47 and 48 of co-pending Application No. 10/326,338 in view of McBrien et al (U.S. Patent 5,328,648).

The present application and U.S. Patent Application No. 10/326,338 are commonly owned. A terminal disclaimer over U.S. Patent Application No. 10/326,338 is enclosed.


It is believed that the filing of this terminal disclaimer removes U.S. Patent Application No. 10/326,338 as the basis for this rejection and thereby overcomes this rejection.

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In view of the above remarks, reconsideration and allowance of Claims 1-11, 13-29 and 31-32 are respectfully requested.

Respectfully submitted,

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